

AF/3713 #



09/456,833

08/09/2002

DOCKET NO.: KAW-215-USAP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: Yoshikazu SAKAMOTO, et al.

#14 Response (new) attach
8/14/02

Serial No.: 09/456,833

Art Unit: 3713

Filed: December 7, 1999

Examiner: J. Hotaling

For: GAMING MACHINE

PETITION TO WITHDRAW FINAL REJECTION

Assistant Commissioner for
Patents & Trademarks
Washington, D.C. 20231

BOX: PETITIONS

Sir:

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TECHNOLOGY CENTER R3700

The Examiner has in the Office Action dated July 17, 2002 for the first time added a completely new rejection of non-amended claims 1, 27 and also claims 28 - 34 (which were presented for the first time on March 18, 2002). The new rejection of claims 1 - 27 is based upon prior art cited to the Examiner in an Information Disclosure Statement filed on June 27, 2002. In this Information Disclosure Statement, Applicant submitted art which was newly brought to Applicant's attention by the communication from Europe dated June 6, 2002. The two new references are GB 2,262,642 and EP 0 875 870 A2. Neither of these references were known to Applicant as stated in the Information Disclosure Statement until well after the filing of Applicant's previous amendment on March 18, 2002.

MPEP § 707.07(a) provides that a final rejection is proper only when the new ground of rejection is not necessitated by amendment (there were not amendments in claims 1 - 27) nor based on

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information submitted in Information Disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p). Here, the critical fact is that Applicant filed no fee with the Information Disclosure Statement because applicant was able to certify under 37 CFR § 1.97(e) that the items submitted first became available to Applicant on June 6, 2002. Therefore, it is clearly improper to make this new ground of rejection final.

The Examiner has used the rejection based upon Sunaga '393 to improperly make final a rejection based upon prior art unknown to anyone until after the previous action was issued. The rejections based upon the newly cited art are new grounds of rejection never submitted before and ,therefore, require withdrawal of the final rejection as required by MPEP § 706.07(3).

Applicant relies upon § 706.07(a) which provides that in cases where the Examiner should anticipate a Statement of Common Ownership, the Examiner should not make the next office final if a new rejection is made. Here, a new rejection was made, and the Examiner knew very well that a Statement of Common Ownership was to be filed.

The Office Action dated July 17, 2002 was two separate rejections. The first is based upon a previous rejection of claims 1 - 27 as being unpatentable over US Patent 6,159,098 in view of US Patent 6,227,970 in further view of US Patent 6,106,393. This rejection made final the previous rejection and only rejection in the Office Action of December 27, 2001 where the only outstanding rejection was as stated above. In Applicant's Amendment filed on March 18, 2002, Applicant stated as follows:

"Claims 1 - 27 have been rejected under 35 USC § in view of Sunaga '393."

Since the Statement of Common Ownership is now been filed, it applies to the Statement of Common Ownership issue, and has now bearing whatsoever on the new rejection. In short, Applicant has been given no opportunity to respond to respond to the second new ground of rejection as it is for this reason, in order to provide fair and reasonable prosecution Applicant should be given an opportunity to respond.

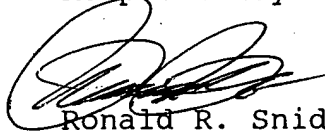
The proper procedure should have been to make the rejection based upon Sunaga '393 final and to make a new non-final rejection based upon the new art if the statement was submitted overcoming the final.

Conclusion

Since the new ground of rejection was improperly made final, this final rejection must be withdrawn.

Enclosed is a check in the amount of \$130.00 to cover the fee for filing this petition. The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account 19-2816. A duplicate copy of this Transmittal is attached.

Respectfully submitted,


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Date: August 9, 2002

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